

Serial No. 10/759,904
ERIC J. BECKMAN ET AL.

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REMARKS

In the Office Action dated September 11, 2007, the Examiner acknowledged Applicant's Request for Continued Examination filed June 27, 2007 and withdrew the finality of the previous Office Action.

However, the Examiner required restriction to one of the following asserted inventions 35 U.S.C. Section 121:

- I. Claims 1-12,15-16,18-26 and 69, drawn to a biodegradable and biocompatible polyurethane with at least one bioactive agent, classified in class 424, subclass 78.27.
- II. Claims 27-39 and 49 drawn to a method for the synthesis of a biodegradable and biocompatible polyurethane, classified in class 522, subclass 90.

Specifically, the Examiner asserted that:

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a materially different process that would not require synthesizing polyurethane by converting an amine group of a biocompatible compound with at least two amine groups to isocyanate groups. One such process to synthesize the polyurethane would be to simply use a commercially available diisocyanate instead of functionalizing a diamine into the corresponding diisocyanate.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Applicants hereby elect Claims 1-12,15-16,18-26 and 69 of Group I set forth by the Examiner with traverse.

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Initially, Applicants note that functionalizing a diamine into the corresponding diisocyanate is not a recited action in the method claims of Group II. The limitation in claim 27 that the multifunctional isocyanate compound is formed via conversion of amine groups of a biocompatible compound having at least two amine groups to isocyanate groups is descriptive of the multifunctional isocyanate compounds that are suitable for use in the method of claim 27 and not a recitation of an action taken in the claimed method. One can use a commercially available multifunctional isocyanate which is an isocyanate functional analog of a biocompatible compound having at least two amine groups (for example, commercially available lysine diisocyanate) within the method of Group II.

Further, Applicants respectfully assert that the examination of the claims of Groups I and II will require search of the same or similar art. Indeed, the Examiner has cited the same art against the claims of Groups I and II in previous office actions on the merits. Applicants respectfully assert that the examination of the claims of Groups I and II would not be burdensome upon the Examiner and that, in the interest of expedient and efficient prosecution, the claims of Groups I and II should be examined together.

Applicants respectfully request that the Examiner withdraw the restriction requirement, indicate the allowability of the claims and arrange for an official Notice of Allowance to be issued in due course.

Respectfully submitted,
ERIC J. BECKMAN et al.

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By Henry E. Bartony, Jr.
Henry E. Bartony, Jr., Esq.
Reg. No. 34,772

Bartony & Hare, LLP
1806 Frick Building
437 Grant Street
Pittsburgh, Pennsylvania 15219-6101
412-338-8632 (telephone)
412-338-6611 (fax)

Attorney for Applicant